

R E M A R K S

Claims 1-9 and 11 are pending and stand ready for further action on the merits. Claim 10 has been cancelled.

The claims have been amended to recite that the photocatalyst is in particle form. Support for this description can be found on page 6, line 15 of the present specification.

Claims 1, 6 and 9 have also been amended to recite the subject matter of cancelled claim 10.

No new matter has been added by way of the above-amendment. The following sections correspond to the sections of the outstanding Office Action.

Election/Restriction

In response to Applicants' addition of new claims 8-11 in the December 29, 2003 Amendment, the Examiner has taken the position that new claim 8 is drawn to a different category of invention than the invention described in claims 1-7 and 9-11. Accordingly, the Examiner has withdrawn claim 8 from consideration as being drawn to non-elected subject matter by original presentation.

Applicants respectfully traverse the newly imposed Restriction Requirement.

According to MPEP §803, if the search and examination of an

entire application can be made without a serious burden, the Examiner *must* examine it on the merits, even though it includes claims to independent or distinct inventions. As evidence of the undue burden, the Examiner has listed a single class to be searched for each of Groups I and II. Clearly the search of one extra subclass would not amount to an undue burden on the Examiner to consider all of claims 1-9 and 11. As such, Applicants respectfully request that the Examiner rejoins Group II with Group I.

However, should the Examiner maintain the restriction requirement, Applicants respectfully remind the Examiner that should the product claims be found allowable, the process (of making and/or using) claims which depend from or otherwise include all the limitations of the allowable product claims are to be rejoined, see MPEP § 821.04.

Issues under 35 U.S.C.102

The following prior art rejections are pending:

(A) Claims 1-7 and 9-11 are rejected under 35 U.S.C. §102(b) as being anticipated by Mouri et al., U.S. 5,690,922;

(B) Claims 1-7 and 9 are rejected under 35 U.S.C. §102(b) as being anticipated by Hu et al., U.S. 5,385,753; and

(C) Claims 1-7 and 9 are rejected under 35 U.S.C. §102(e) as being anticipated by Ogata et al., U.S. 6,238,631.

With regard to rejections (B) and (C), Applicants respectfully submit that independent claims 1, 6 and 9, as originally filed, are neither anticipated nor rendered obvious by Hu et al. or Ogata et al. However, in order to advance prosecution, Applicants have amended the independent claims to recite the subject matter of claim 10, a claim not currently under rejection. As such, rejections (B) and (C) are rendered moot.

With respect to rejection (A), Applicants respectfully submit that independent claims 1, 6 and 9 are patentable over Mouri et al., since Mouri et al. fail to teach or fairly suggest the use of a photocatalyst in the particle form.

Mouri et al. invariably teach that the photocatalyst is in fiber form. Based on the list of possible uses given at column 15, line 46 to column 17, line 10, it is clear that Mouri et al. do not envision that the fibrous photocatalyst would be useful in the particle form.

In describing the requirements for rejection of a claim by anticipation, the Manual of Patent Examining Procedure (Section 2131) states:

[a] claim is anticipated only if each and every element as set forth in the claim is found, either expressly or inherently described, in a single prior art reference (ref. omitted). The identical invention must be shown in as complete detail as is contained in the... claim (ref. omitted).

Accordingly, every element in a claim must be found in the reference in order that the reference anticipates the claim. Mouri et al. fail to teach or fairly suggest the use of a photocatalyst in the particle form. Therefore, Mouri et al. do not anticipate the claims, and as such, Applicants respectfully request that rejection (A) be withdrawn.

Conclusion

In view of the above amendments and comments, Applicants respectfully submit that the claims are in condition for allowance. However, should the Examiner find to the contrary, the Examiner is respectfully requested to enter this Reply into the official file to place the claims in better form for appeal.

If the Examiner has any questions concerning this application, he is requested to contact Garth M. Dahlen, Ph.D., Esq. (#43,575) at the offices of Birch, Stewart, Kolasch & Birch, LLP.

If necessary, the Commissioner is hereby authorized in this, concurrent, and future replies, to charge payment or credit any overpayment to Deposit Account No. 02-2448 for any additional fees required under 37 C.F.R. § 1.16 or under § 1.17; particularly, extension of time fees.

Respectfully submitted,

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